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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/176,664	10/21/98	SALKOFF	L 018512-00012

020350 HM12/1217  
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EXAMINER

BASI,N

ART UNIT

PAPER NUMBER

1646

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DATE MAILED: 12/17/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/176,664**

Applicant(s)

**Salkoff et al**

Examiner

**Nirmal. S. Basi**

Group Art Unit

**1646**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-44 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-44 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1646

### DETAILED ACTION

1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1646.

2. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

3. ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 17-21 drawn to isolated polypeptide which specifically binds polyclonal antibodies generated against SEQ ID NOs:1, 3, 16 or, classified in class 530, subclass 350.
- II. Claims 1-16 and 26-27, drawn to isolated nucleic acid encoding a polypeptide monomer of a pH sensitive potassium channel which specifically bind to polyclonal antibodies generated against SEQ ID NOs:1, 3, 16 or 18, expression vectors

Art Unit: 1646

encoding, cells containing the afore mentioned expression vectors, classified in class 536, subclass 23.1, for example .

III. Claims 22-25, drawn to antibody that binds to mSlo3 or hSlo3, classified in class 530, subclass 387.9, for example.

5 IV. Claim 28-34, drawn to method for identifying a compound that increases or decreases ion flux through pH sensitive potassium channel, classified in class 435, subclass 7.1 for example.

V. Claim 35-37, drawn to method for detecting the presence of Slo3 in mammalian tissue, classified in class 435, subclass 7.1 for example.

10 VI. Claims 38-39 drawn to computer system and method for screening for mutations of Slo3 genes, classified in class 702, subclass 20.

VII. Claims 40-44 drawn to computer system, method for identifying a three dimensional structure of Slo proteins, classified in class 702, subclass 22.

The inventions are distinct, each from the other because of the following reasons:

15 The proteins of Invention I are related to the nucleic acids of Invention II by virtue of encoding the same. The DNA molecule has utility for the recombinant production of the protein in a host cell. Although the DNA molecule and protein are related since the DNA encodes the specifically claimed protein, they are distinct inventions because they are physically and functionally distinct chemical entities, and the protein product can be made by another and  
20 materially different process, such as by synthetic peptide synthesis or purification from the natural

Art Unit: 1646

source. Further, the DNA may be used for the processes other than the production of the protein, such as nucleic acid hybridization.

The proteins of Invention I are related to antibodies of Invention III by virtue of being the cognate antigen, necessary for the production of the antibodies. Although the protein and antibody are related due to the necessary steric complementary of the two, they are distinct inventions because they are physically and functionally distinct chemical entities, and because the protein can be used in another and materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right or in assays for the identification of agonists of the receptor protein.

The proteins Inventions I and the methods of Inventions IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the proteins may be used for the production of antibodies of Invention III.

The products of Inventions I, II and III are distinct from each other because they have distinct functional, chemical and physical properties and are capable of separate use and manufacture.

Art Unit: 1646

The products of Invention II and III are distinct from the method of Invention IV-VII wherein the products of Invention II and III can neither be used in nor made by the method of Invention IV-VII.

5 The product of Invention I are distinct from the method of Invention VI-VII wherein the products of Invention I can neither be used in nor made by the method of Invention VI-VII.

The methods of Inventions IV- VII are distinct from each other because they are independent, using separate method steps, active agents and having different effects.

10 Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, restriction for examination purposes as indicated is proper. A search of the art for Inventions I-~~IX~~<sup>VII</sup> would not be co-extensive with each other. Because the searches required for these inventions are not co-extensive an examination of the materially different, patentably distinct inventions in a single application would constitute a serious burden on the examiner.

15 Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

Serial Number:09/156,926

Page 6

Art Unit: 1646

amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

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Art Unit: 1646

**Advisory Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi whose telephone number is (703) 308-9435. The examiner can normally be reached on Monday-Thursday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Nirmal S. Basi  
Art Unit 1646  
December 13, 1999

*Elizabeth C. Kemmerer*

ELIZABETH KEMMERER  
PRIMARY EXAMINER





# RESTRICTION ELECTION FACSIMILE TRANSMISSION

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